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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/077,765

02/20/2002

Kazuhiro Ishida

017446-0323

3462

22428 7590 11/02/2009
FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

11/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/077,765	Applicant(s) ISHIDA, KAZUHIRO	
	Examiner Raquel Alvarez	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-37,39-44,46-51,53 and 54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-37,39-44,46-51,53 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/20/09, 7/21/09</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 7/21/2009.
2. Claims 34-37, 39-44, 46-51 and 53-54 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 34-38, 39-44, 46-51 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (5,987,424 hereinafter Nakamura) in view of Kenney (5,515,424 hereinafter Kenney).

With respect to claims 34,36-37, 39-41, 43-44, 46-48, 50-51, 53-54 Nakamura teaches a communication terminal (i.e. subscriber telephone set 1); a registration request issuing means for issuing a registration request for advertisement information broadcast from an advertisement information broadcast server and receiving means for receiving advertisement information which is broadcast from said advertisement information broadcast server, based on said registration request (i.e. the telephone set under contract to receive messages)(steps 1301 and 1302); and a display means for displaying said advertisement information received by said receiving means (Figure 14).

With respect to said display means for automatically displaying said advertisement information on a standby screen when the communication terminal is in

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standby state. Kenney teaches “the monitor 18 would **display informational screens for a period of 8-10 seconds each when the phone is not in use.** These still images are stored in a memory module 38, which could be a disk drive, in the phone. In some cases, the data could be downloaded from a central administration point” (col. 4, lines 27-32). It would have been obvious to a person of ordinary skill in the art at the time of Applicant’s invention to have included automatically receiving advertisement information on a standby screen because such a modification would without any human interaction attract passerby to the telephone terminals.

With respect to the communication terminal being portable. Official Notice is taken that it is old and well known for devices or the like to be portable in order to provide portability. It would have been obvious to a person of ordinary skill in the art at the time of Applicant’s invention to have included the communication terminal being portable in order to obtain the above mentioned advantage.

With respect to claims 35, 42, 49, Nakamura further teaches a registration cancellation means for requesting to stop broadcasting said advertisement information from said advertisement information broadcast server (i.e. exchange 4 determining if a cancellation request was received from the subscriber telephone set 1)((col. 24, lines 29-33).

Response to Arguments

5. The IDS filed on April 20, 2009 has been considered and a copy has been submitted with this office action.

6. The 101 rejection has been withdrawn.

7. Applicant argues that Nakamura nor Kenney teaches a portable communication terminal. The Examiner had taken official notice that making a device portable it is old and well known in order to provide portability. See rejection above.

8. Applicant argues that Neither Nakamura nor Kenney teaches automatically displaying advertisements on a standby screen when the communication terminal is in a standby state. The Examiner disagrees with Applicant the claims were rejected under 103 and Kenney clearly teaches the monitor 18 would **display informational screens for a period of 8-10 seconds each when the phone is not in use.** These still images are stored in a memory module 38, which could be a disk drive, in the phone. In some cases, the data could be downloaded from a central administration point" (col. 4, lines 27-32). As can be seen by Kenney the advertisements are displayed automatically every 8-10 seconds when the phone is in standby mode (not in use).

9. Applicant further argues that Kenny doesn't teach or is distinct from the present invention in that in Kenney the targeting is at a general public or an unspecified large number of people as oppose to the present invention which the targeting is based on a requested content from each terminal. The Examiner wants to point out that the claims were rejected under the doctrine of 103 and therefore they should be argued

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accordingly. Nakamura instead of Kenney was the reference cited to teach each telephone set under contract to receive time zone advertisements (steps 1301 and 1302). As can be seen by Nakamura the advertisements being on the individual's terminal contract and time zone.

10. Applicant argues that Kenney doesn't teach the communication terminal has a registration request for issuing a registration request for advertisement information from an advertisement information broadcast server. The Examiner wants to point out that the claims were rejected under the doctrine of 103 and that Nakamura was the reference cited to teach the subscriber under contract and receiving advertisement via exchange (server) and therefore the references have to be argued accordingly.

Applicant is reminded that in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Weinhardt can be reached on (571)272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
10/27/2009